



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/584,714

06/23/2006

Gunnar Glad

PU03100

5090

22840

7590

07/09/2009

GE HEALTHCARE BIO-SCIENCES CORP.
PATENT DEPARTMENT
800 CENTENNIAL AVENUE
PISCATAWAY, NJ 08855

EXAMINER

THERKORN, ERNEST G

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

07/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,714	Applicant(s) GLAD ET AL.	
	Examiner Ernest G. Therkorn	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 3,6,10,11 and 13-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/23/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1797

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, 5, 7-9, and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 11/570,530 in view of in view of Muller (U.S. Patent No. 5,453,186). At best, the claims differ from the claims of copending Application No. 11/570,530 in reciting that an R group from sulphonyl is an aliphatic compound. Muller (U.S. Patent No. 5,453,186) (column 4, lines 60-61; column 5, lines 4-10 and 47-56) discloses that alkyl sulfonyl, including methyl sulfonyl, bonded to an amine is a preferred alternative to aromatic sulphonamides. It would have been obvious to use ethyl sulfonyl as the claims of copending Application No. 11/570,530's R² group because Muller (U.S. Patent No. 5,453,186) (column 4, lines 60-61; column 5, lines 4-10 and 47-56) discloses

Art Unit: 1797

that alkyl sulfonyl, including methyl sulfonyl, bonded to an amine is a preferred alternative to aromatic sulphonamides.

This is a provisional obviousness-type double patenting rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 7-9, and 12 are rejected under 35 U.S.C. 102(B) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Berglund (U.S. Patent No. 5,090,288). The claims are considered to read on Berglund (U.S. Patent No. 5,090,288). However, if a difference exists between the claims and Berglund (U.S. Patent No. 5,090,288), it would reside in optimizing the elements of Berglund (U.S. Patent No. 5,090,288). It would have been obvious to optimize the elements of Berglund (U.S. Patent No. 5,090,288) to enhance separation.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berglund (U.S. Patent No. 5,090,288) in view of Muller (U.S. Patent No. 5,453,186). At best, the claim differs from Berglund (U.S. Patent No. 5,090,288) in reciting use of a methyl group. Muller (U.S. Patent No. 5,453,186) (column 4, lines 60-61; column 5, lines 4-10

and 47-56) discloses that alkyl sulfonyl, including methyl sulfonyl, bonded to an amine is a preferred ligand. It would have been obvious to use a methyl group in Berglund (U.S. Patent No. 5,090,288) because Muller (U.S. Patent No. 5,453,186) (column 4, lines 60-61; column 5, lines 4-10 and 47-56) discloses that alkyl sulfonyl, including methyl sulfonyl, bonded to an amine is a preferred ligand.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berglund (U.S. Patent No. 5,090,288) in view of Muller (U.S. Patent No. 5,453,186). At best, the claim differs from Berglund (U.S. Patent No. 5,090,288) in reciting use of repeating units. Muller (U.S. Patent No. 5,453,186) (column 7, lines 46-62) discloses that use of repeating units allows the creation of the optimum separation material and allows for a very much higher binding capacity. It would have been obvious to use repeating units in Berglund (U.S. Patent No. 5,090,288) because Muller (U.S. Patent No. 5,453,186) (column 7, lines 46-62) discloses that use of repeating units allows the creation of the optimum separation material and allows for a very much higher binding capacity.

Claims 1, 2, 4, 5, 7-9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto (U.S. Patent No. 4,725,355) in view of Muller (U.S. Patent No. 5,453,186) and Wikipedia. At best, the claims differ from Yamamoto (U.S. Patent No. 4,725,355) in reciting that an R group from sulphonyl is an aliphatic compound. Muller (U.S. Patent No. 5,453,186) (column 4, lines 60-61; column 5, lines 4-10 and 47-56) discloses that alkyl sulfonyl, including methyl sulfonyl, bonded to an amine is a preferred alternative to aromatic sulphonamides. Wikipedia evidences that sulfonamide and sulfa drug are synonyms. It would have been obvious to use ethyl sulfonyl as

Art Unit: 1797

Yamamoto (U.S. Patent No. 4,725,355)'s column 4, lines 1-13 R² group because Muller (U.S. Patent No. 5,453,186) (column 4, lines 60-61; column 5, lines 4-10 and 47-56) discloses that alkyl sulfonyl, including methyl sulfonyl, bonded to an amine is a preferred alternative to aromatic sulphonamides and Wikipedia evidences that sulfonamide and sulfa drug are synonyms.

The remarks urge that the restriction requirement is improper because claim 1 is patentable. The above rejections further evidence that claim 1 is unpatentable. As such, the restriction and elections of species have been reconsidered, deemed proper, and made final for the reasons of record.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (571) 272-1149. The official fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ernest G. Therkorn/
Ernest G. Therkorn
Primary Examiner
Art Unit 1797

EGT
July 2, 2009